

Notice of Allowability

Application No.

09/175,683

Applicant(s)

CHEN ET AL.

Examiner

Richard Schnizer, Ph. D.

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/21/07.
2. ☒ The allowed claim(s) is/are 85-92.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 10/19/07;10/21/07
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: This application was previously allowed on 4/20/07 and an amendment under 37 CFR 1.312 was entered on 7/20/07 to correct a typographical error of claim dependency.

Subsequently Applicant petitioned to withdraw from issue and to file a statement pursuant to the duty of disclosure under 37 CFR 1.56, 1.97, and 1.98. In the statement, filed 9/12/07, Applicant brought to the Examiner's attention the prosecution histories of applications 09/175,684, 10/949,975, 10/082,018, and 11/140,676.

The 10/949,975 application has claims that overlap in scope with the instant claims. Because this application is being allowed first, there is no need for a terminal disclaimer over the '975 claims.

The 09/175,684 application has issued as US 6,593,463, with claims drawn to nucleic acids useful for making transgenic animals. Claims to nucleic acids were restricted from claims to transgenic animals in that application. Accordingly, the Examiner sees no need for a terminal disclaimer over the '463 claims in the instant application.

The 10/082,018 application was allowed on 9/17/07. The '018 application and the instant application have the same effective filing date. The allowed claims overlap the instant claims in scope, and a terminal disclaimer over the instant claims was filed in the '018 application. The instant claims are broader, so this application is considered to claim the "base invention" according to MPEP 804(I)(B)(1), and no terminal disclaimer over the '018 claims is required in this application.

The pending claims in the 11/140,676 application are directed to compositions comprising polypeptides. Because this application is being allowed first, there is no need for a terminal disclaimer over the '676 claims.

Although Applicant submitted on 9/12/07 a list of documents from each application cited above to be considered by the Examiner, and indicated that the list of documents on any attached PTO-1449 or modified PTO/SB/08 was to be made of record, there was no PTO-1449 or modified PTO/SB/08 in the amendment filed 9/12/07. Further, the list of documents submitted on 9/12/07 was not a proper information disclosure statement under 37 CFR 1.98 because it lacked a column for providing a space next to each document for the Examiner's initials, a heading that clearly indicated that the list was an information disclosure statement, and identification of each application by inventor and filing date. For these reasons the list was not initialed or signed by the Examiner.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 571-272-0762. The examiner can normally be reached Monday through Friday between the hours of 6:00 AM and 3:30. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

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If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, J. Douglas Schultz, can be reached at (571) 272-0763. The official central fax number is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

A handwritten signature in black ink, appearing to read 'RS', with a long horizontal flourish extending to the right.

Richard Schnizer, Ph.D.
Primary Examiner
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